

APR 25 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Michael D. Zoeckler)	Examiner: Harmon, Christopher R.
)	
Serial No.: 09/559,704)	Art Unit: 3721
)	
Filed: 04/27/2000)	Attorney Docket No.: 7137 (R029 1056)
)	
For: PAPERBOARD CARTONS WITH)	
LAMINATED REINFORCING RIBBONS)	
AND METHOD OF MAKING SAME)	
)	

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed February 24, 2005, which was in response to the Appeal Brief filed February 2, 2005, entitled "Substitute Amended Appeal Brief." The Substitute Amended Appeal Brief responded to the Office Action mailed August 25, 2004. For expediency, Appellant will address only selected sections of the Examiner's Answer according to the numbering system used therein.

(5) Summary of Claimed Subject Matter

The Examiner's Answer indicated:

The summary of claimed subject matter contained in the brief is present however is not fully agreed with ie. persuasive arguments/statements contained therein.

This language is vague and confusing. Appellant does not understand from the language what objection the Examiner has to the summary of the claimed subject matter of section 5 in the

Substitute Amended Appeal Brief. The only subject matter included in section 5 is taken directly page and line from the specification. The highlighting added by Appellant was provided to indicate support for claim elements as required in the Brief. Appellant fails entirely to understand the Examiner's reference to "persuasive arguments/statements" therein and requests the Examiner withdraw the objection (if, indeed, it is an objection) to section 5, or provide clarification.

(10) Response to Argument

The Examiner's Answer provides in § 10 "Response to Argument" that:

The language "substantially all of a selected panel portion of the web" is extremely broad. Note: During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 19997). See MPEP §904.1. Therefore any portion of any panel that is adhered to and covered by another (reinforcing) layer could be reasonable selected.

Even if the language "substantially all of a selected panel portion of the web" is considered broad, such phrase is definite enough to allow one of ordinary skill in the art to ascertain the claim scope. To wit, the Examiner has not rejected this claim limitation as indefinite at any time during examination. Accordingly, the claims should indeed be given "the broadest reasonable interpretation consistent with the specification." However, the applied reference(s) must still show each and every feature to reject a claim. *Stone* fails to show each and every feature of the claim regardless of the breadth of the interpretation.

Specifically, the *Stone* reference entirely fails to disclose a reinforcing material "positioned to overlie and adhere to substantially all of a selected panel portion of the web" as claimed. *Stone* does not, and cannot, show adherence of a reinforcing material over the panel portions selected by the Examiner. In fact, the flip-top box of *Stone* would be inoperable if the collar that aligns the box top, which the Examiner equates to a reinforcing ribbon, was so

adhered. Specifically, on erection of the *Stone* flip-top box carton, panel portions 56 and 58 (each of which has been used as a basis of rejection by the Examiner) become the peripheral lips of the openable lid as shown in Fig. 4. Thus, clearly, if the strip 24 were "adhered" to the panel portion 56 or 58 as claimed, the lid would not open because the lips of the lid would be stuck (adhered) to the rim formed by strip 24.

The points of adhesion in *Stone* cannot read on the claim limitation of adhering to substantially all of a selected panel portion because the collar is only adhered at approximately only half of any selected panel. Specifically, *Stone* states in column 3, line 66 through column 4, line 2 that in order to

permit the lid 30 to be raised upwardly from the base section 32 while the collar 24 is retained on the base section 32 (FIG. 4), the collar 24 is adhered to the carton 10 only at locations below the tear strip 27.

Further, *Stone* continues in column 5, lines 3-5 that

the strip 38 of collar material is simultaneous [sic] cut and scored to produce a collar blank 46 which is also illustrated in FIG. 3. The collar blank 46 is fixedly adhered to the carton blank 44 at locations to the right of the tear-tape band 26 and the tear strip 27 (as viewed in FIG. 3).

As shown in the attached marked up Fig. 3, each of the panel portions 56 and 58 comprise approximately equal sized sections to the left and right of tear strip 27. Since panel 56 or 58 can only be adhered on one side of the tear strip 27 and since a claim limitation of adhesion to substantially all of a panel is not met by a teaching of adhesion to approximately half of the panel, panels 56 and 58 cannot meet the definite limitations of independent claims 1 and 25.

Additionally, the Examiner states in the Examiner's Answer that:

Furthermore, *Stone* specifically discloses modifying the width of the reinforcing collar 24 (also reinforcing strip 38) providing "the collar 24 may be modified so that the collar is relatively narrow ...

or relatively wide" column 6, lines 43-44. Widening of the strip 38 would anticipate appellant's narrow interpretation of this limitation ie. the smallest "selected panel portion" 50 would be substantially covered and adhered to by reinforcing material 38; see figure 3.

Appellant disagrees. Even if this assertion by the Examiner were true and the box of *Stone* was modified as suggested by the Examiner, *Stone* would continue to fail to disclose the limitations of claims 1 and 25. As shown above, *Stone* specifies in column 3, line 66 through column 4, line 2 that in order to "permit the lid 30 to be raised upwardly from the base section 32 while the collar 24 is retained on the base section 32 (FIG. 4), the collar 24 is adhered to the carton 10 only at locations below the tear strip 27." Thus, even if the strip 38 were widened as proposed by the Examiner, the collar would continue to be adhered only at locations below the tear strip 27, still failing to disclose adhesion to substantially all of a selected panel portion. *Stone* fails entirely to provide a teaching, suggestion, or even inherent support for the Examiner's proposed change. Further, as discussed above, since *Stone* is a flip-top box, adhesion of substantially all of a panel of the collar would destroy the functionality of the reference. Since destroying the functionality of a reference cannot support modification of a reference, the Examiner's proposal is improper.

The Examiner has also maintained the rejection of Claims 4-7 and 30-33 based on a combination of *Stone* with *Stokes*. However, *Stokes* entirely fails to make up for the inadequacies of *Stone* by failing to provide a teaching or suggestion to modify *Stone* to show a reinforcing ribbon that overlies and adheres to substantially all of a selected panel portion. Accordingly, rejections based on the combination of *Stone* and *Stokes* are improper.

The Examiner has also maintained the rejection of claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 as being unpatentable over *Lang*. As discussed in the Substitute Amended Appeal Brief,

Lang fails to disclose each and every element of these claims and rejections based thereupon are improper. In the Examiner's Answer, a reasoned argument of support for the Appellant's inclusion of "non-corrugated" in the claims is provided. However, the Examiner entirely fails to show a teaching or suggestion in *Lang* to support the missing elements of the claims discussed in the Substitute Amended Appeal Brief. Specifically, *Lang* fails to teach or suggest applying a ribbon of reinforcing material directly to another web of non-corrugated material over substantially all of a panel portion as claimed. The Examiner has failed to address (1) that *Lang* merely teaches applying a "finishing layer" onto a corrugated material, (2) that *Lang* fails to disclose, teach, or suggest applications to non-corrugated paperboard, (3) that cartons made according to the present invention have enjoyed substantial commercial success (evidence of continued commercial success following the period addressed in the Affidavit provided with the Substitute Amended Appeal Brief can be supplied to the Board if requested), (4) that the methods of *Lang* present drawbacks addressed specifically by the present invention, (5) that official notice cannot be taken without prima facie evidence support, once the burden has been switched back to the Examiner, and (6) that the modifications of *Lang* proposed by the Examiner must be taught or suggested by *Lang* or must actually be obvious and "well known" in the art supported by documentary evidence. Since *Lang* fails to disclose each and every element of the claimed invention, and in light of the foregoing shortcomings of the Examiner's position, rejections based thereupon should be withdrawn as moot.

CONCLUSION

Claims 1-3, 11-16, 25-29, and 34 are not anticipated by *Stone* under 35 U.S.C. § 102(b).

Claims 4-7 and 30-33 are not rendered obvious by *Stone* in view of *Stokes* under 35 U.S.C.

103(a). Claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 are not rendered obvious by *Lang* under 35 U.S.C. § 103(a).

For the foregoing reasons, the rejections of claims 1-7, 9-16, and 25-34 by the U.S. Patent and Trademark Office are in error. Reversal of the rejections and allowance of the application is respectfully requested.

AUTHORIZATION

Although the Applicant does not believe any fee is due by the filing of this Reply Brief, the Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,

4/25/05
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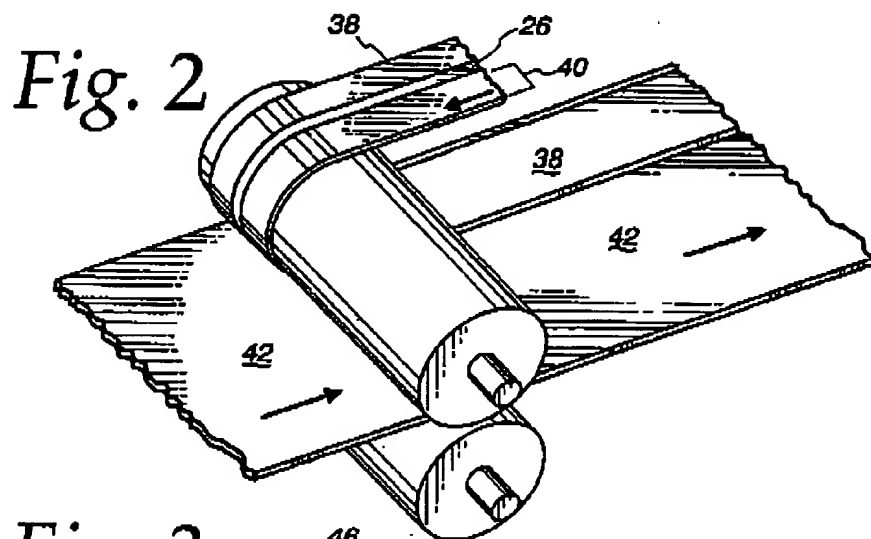
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U.S. Patent

Sep. 3, 1996

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*Fig. 3*